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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,882	12/09/2003	James Rohl	279.630US1	6739
21186	7590	07/27/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			HAMILTON, ISAAC N	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/731,882

Applicant(s)

ROHL ET AL.

Examiner

Isaac N. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a method of forming an electrode layer for a flat capacitor having no stripper plate.
- II. Claims 6-9, drawn to a punch and die apparatus having the punch guide and the die with a fixed distance therebetween.
- III. Claims 10-12, drawn to a method of forming an electrode layer for a flat capacitor delivering a lubricant to a periphery of the die hole.
- IV. Claims 13-16, drawn to a punch and die apparatus having a lubrication dam and a lubrication inlet.
- V. Claims 17-20, drawn to a method of forming an electrode layer for a flat capacitor having a lubricating fluid that is compatible with a chemistry of the sheet.
- VI. Claims 21-23, drawn to a method of forming a punch guide and die set.
- VII. Claims 24-27, drawn to a punch and die apparatus having a compound shear angle.
- VIII. Claims 28-31, drawn to a method of forming an electrode layer for a flat capacitor having a punch surface with a compound shear angle.
- IX. Claims 32-35, drawn to a punch and die apparatus having a punch with a surface perimeter that includes two large radii and two small radii.

- X. Claims 36-39, drawn to a method of forming an electrode layer for a flat capacitor providing a punch having a surface perimeter that includes two large radii and two small radii.
- XI. Claims 40-43, drawn to a punch and die apparatus having a pick up member to retrieve a part from the punch surface on the second side of the die.
- XII. Claims 44-46, drawn to a method of forming an electrode layer for a flat capacitor by taking the electrode layer off the punch through a second side of the die.
- XIII. Claims 47-49, drawn to a method of forming an electrode layer for a flat capacitor by picking the electrode layer off with a vacuum member having two independent vacuum ports.
- XIV. Claims 50-52, drawn to a method of forming an electrode layer for a flat capacitor having a carbide die and a carbide punch.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, III, V, VIII, X, XII, XIII and XIV, and inventions II, IV, VII, IX and XI are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as forming a rear wall for a metal bookcase.

Invention VI and inventions II, IV, VII, IX and XI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1)

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that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another materially different process, such as, a process that forms only one guide hole in the block of material, or a process that forms a deep recess in the block of material and is separated into three sections instead of two sections.

Inventions VI and inventions I, III, V, VIII, X, XII, XIII and XIV are related as process of making a product and process of using a product. The inventions are distinct if it can be shown that either: (1) the product made by the process as claimed can be operated by another and materially different process (2) the product used in the process can be made by another and materially different process. In the instant case, the product as claimed can be made by another materially different process, such as, a process that forms only one guide hole in the block of material, or a process that forms a deep recess in the block of material and is separated into three sections instead of two sections. It is to be noted that if the process of making is elected, and the product claim is held to be allowable, then the process of making will be rejoined with the product and subsequently be allowable.

Inventions II, IV, VII, IX and XI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. See MPEP § 806.05(d). For example, Invention II and Invention IV do not overlap in scope because Invention II limits the apparatus to having a fixed distance between the punch guide and the die, on the other hand, Invention IV limits the apparatus to having a

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lubrication dam and a lubrication inlet. Additionally, the subcombinations are separately usable because a punch and die apparatus can operate without having a lubrication dam and lubrication inlet. Conversely, a punch and die apparatus can operate using a lubrication dam and a lubrication inlet, and also have the punch guide and die adjustable relative to one another in order to vary the distance between them.

Inventions I, III, V, VIII, X, XII, XIII and XIV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. See MPEP § 806.05(d). For example, Invention III and Invention XIII do not overlap in scope because Invention III limits the method to having a lubricant applied to the periphery of the die hole, on the other hand, Invention XIII limits the method to having the electrode layer picked off with a vacuum member. Additionally, the subcombinations are separately usable because a punching method with a vacuum pickoff member can operate without having lubrication applied to the periphery of the die hole. Conversely, a punching method can be performed using lubrication, and also have the electrode layer picked off with a magnet or adhesive member.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02(c)), restriction for examination purposes as indicated is proper. For example, a search for Invention II will require text searching for the relationship between elements being constant and may include terms such as “constant” or “distance maintained”, however, a search for Invention III will not require these search terms, and instead requires terms such as “lubricant” or “reduce friction”. Moreover, the search for

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Invention IV may not require any of the terms mentioned above, and instead will require search terms such as “dam” and “inlet”.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*RA*

IH

July 21, 2006

  
KENNETH E. PETERSON  
PRIMARY EXAMINER